

REMARKS/ARGUMENTS

In the Office Action mailed March 17, 2008 (hereinafter, "Office Action"), claims 17-24 stand rejected under 35 U.S.C. § 101. Claim 9 stands rejected under 35 U.S.C. § 112. Claims 1-3, 9-11 and 17-19 stand rejected under 35 U.S.C. § 102. Claims 4-8, 12-16 and 18-24 stand rejected under 35 U.S.C. § 103. Claims 1 and 9-24 have been amended.

Applicant respectfully responds to the Office Action.

I. Specification

The claimed subject matter has been amended to address the Examiner's objections to the specification. Specifically, claims 9-16 have been amended to recite a "memory" instead of a "medium".

II. Objection of Claims 17-24

Claims 17-24 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 17-24 have been amended to address the Office Action's rejection. Applicant respectfully requests that the rejection of claims 17-24 be withdrawn.

III. Claim 9 Rejected Under 35 U.S.C § 112

Claim 9 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 9 as amended recites "A memory readable by a machine embodying a program of instructions executable by the machine to facilitate communication between a client device and a peripheral device over a network that includes the peripheral device, the client device, and a server device adapted to control the peripheral device, the peripheral device having a network address which is not known to the client device, the instructions being configured to:" Support for this amendment can be found in at least Applicant's specification, page 7, lines 7-8 and in Figure 2. In

view of the above amendment, Applicant respectfully requests that the rejection of claim 9 be withdrawn.

IV. Claims 1-3, 9-11 and 17-19 Rejected Under 35 U.S.C. § 102(b)

Claims 1-3, 9-11 and 17-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,889,252 to Lacomme D'Estalens (hereinafter, "Lacomme"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Claim 1 as amended recites "determining the network address of the peripheral device, wherein determining includes: reading a first data file of the server device, said first data file including at least one of (a) the network address of the peripheral device, and (b) a network address of a second data file associated with and including the network address of the peripheral device." Lacomme does not disclose this subject matter.

Instead Lacomme states:

In step 232, once the terminal T has been connected to the server S through a network and a network session has been initiated between T and S, the user sends to the server S: information identifying the selected peripheral P1, indicating that P1 is the peripheral to which output requests issued from the terminal T must be directed, as well as an information identifying the terminal itself. This information can have been already stored by the server at the initiation of the network session between the terminal and the server.

To perform steps 231 and 232, the user can browse a resource list from a

display imported on his terminal screen from the server S to select the desired peripheral.

Such a list can be logically organized and visually presented to the user, in different ways.

(Lacome, col. 6, lines 32-46).

Lacome thus describes obtaining “information identifying the selected peripheral.” This is accomplished by “brows[ing] a resource list from a display imported on his terminal screen.” The cited portion of Lacome does not disclose, nor can Applicant find any portion of Lacome that discloses “a network address of a second data file associated with and including the network address of the peripheral device” as described in claim 1.

Claim 1 as amended also recites “comparing portions of at least one of said first and second data files with a predetermined data formatting pattern indicative of a network address.” Lacome does not disclose this subject matter.

The Office Action has not cited, nor can Applicant find any portion of Lacome that discloses “comparing portions of at least one of said first and second data files with a predetermined data formatting pattern indicative of a network address.”

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from Lacome. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Lacome does not disclose all of the subject matter of claim 1.

Claims 2 and 3 depend either directly or indirectly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 2 and 3 be withdrawn.

Claims 9 and 17 as amended include subject matter similar to the subject matter of claim 1. As such, Applicant respectfully requests that the rejection of claims 9 and 17 be withdrawn because Lacome does not disclose all of the subject matter of claims 9 or 17.

Claims 10 and 11 depend either directly or indirectly from claim 9. Claims 18 and 19 depend either directly or indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 10, 11, 18 and 19 be withdrawn.

V. Claims 4-8, 12-16 and 18-24 Rejected Under 35 U.S.C. § 103(a)

Claims 4-8, 12-16 and 18-24 stand rejected under 35 U.S.C. § 103(a) based on Lacombe in view of U.S. Patent Application Publication No. 2002/0059489 to Davis et al. (hereinafter, "Davis"). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. ___, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). To establish a *prima facie* case of obviousness, the prior art references "must teach or suggest all the claim limitations." M.P.E.P. § 2142. Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at **37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claims 4-8 depend either directly or indirectly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 4-8 be withdrawn for the reasons above.


Claims 12-16 depend either directly or indirectly from claim 9. Accordingly, Applicant respectfully requests that the rejection of claims 12-16 be withdrawn for the reasons above.

Claims 18-24 depend either directly or indirectly from claim 17. Accordingly, Applicant respectfully requests that the rejection of claims 18-24 be withdrawn for the reasons above.

VI. Conclusion

Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wesley L. Austin', written in a cursive style.

/Wesley L. Austin/

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant

Date: June 17, 2008

MADSON & AUSTIN
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: (801) 537-1700